

Docket No. RD-25877

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of (first named inventor): Mark Gilbert Benz

International (PCT) Application No.: PCT/US97/16812

U.S. Application No.

International Filing Date: Alleged: October 22, 1997

Priority Date Claimed: Alleged: none

Title: METHOD FOR DISSOLUTION OF NITROGEN-RICH INCLUSIONS IN TITANIUM AND TITANIUM ALLOYS

PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT
DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37CFR 137(b)Attention: PCT Legal Staff
Box PCT
Assistant Commissioner for Patents
Washington, D.C.20231

RECEIVED

23 OCT 2001

Legal Staff
International Division

Sir:

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set forth in 37 CFR 1.49(b) or (c) or 1.495(b) or (c) (as applicable). The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.49(h) or 1.495(i).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

Note: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Proper reply;
- (3) Terminal disclaimer fee – required for all international applications having an international filing date before June 8, 1995; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity – fee \$ 620.00 (37CFR1.17(m)).

11/08/2001 HNGUYEN 00000014 090470 09889078

01 FC:141
02 FC:1221240.00 CH
130.00 CH☐ Small entity statement enclosed herewith.☐ Small entity statement previously filed.☐ Other than small entity – fee \$ 1240.00 (37CFR 1.17(m)).

I hereby certify that this correspondence is being deposited with sufficient postage to the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, on the date indicated below.

By Dolores K. Tillson
Dolores K. Tillson

Date: July 11, 2001

2. Proper reply

- A. The proper reply (the missing 35 U.S.C. 371(c) requirements) in the form of Declaration of Inventors (identify type of reply):

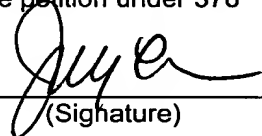
- ☐ has been filed previously on
☐ is enclosed herewith.

3. Terminal disclaimer with disclaimer fee

- ☐ Since this international application has an international filing date on or after June 8, 1995, no terminal disclaimer fee is required.
☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d) of \$ for a small entity or \$ for other than a small entity) equivalent to the period of abandonment is enclosed herewith (see PTO/SB/63).

4. Statement: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 376 CFR 1.137(b) was unintentional.

Date:


(Signature)

Telephone No.: 203-373-2867
Fax No. 203-373-3991

Jay L. Chaskin
General Electric Company
3135 Easton Turnpike
Fairfield, CT 06431

Enclosures: ☐ Fee Payment: The applicant requests that the petition fee in the amount of \$1,240.00 under 37 CFR 1.17(m) should be charged to Deposit Account No. 09-0470. A duplicate copy of this petition is enclosed.

- ☐ Reply
☐ Terminal Disclaimer Form
☐ Small Entity Status Form
☐

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE AS A
RECEIVING/ELECTED OFFICE UNDER THE PATENT COOPERATION TREATY

In re Application of: : METHOD FOR DISSOLUTION OF
NITROGEN-RICH INCLUSIONS IN
Applicant: GENERAL ELECTRIC TITANIUM AND TITANIUM ALLOYS
COMPANY et al.

International Application No. PCT/US97/016812

International Filing Date: Alleged as 22 October 1997

International Filing Date Requested: 22 September 1997

Priority to be claimed: 25 September 1996

PEPTITION TO GRANT A PRIORITY DATE FOR A PCT APPLICATION

Box PCT
U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

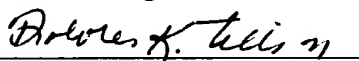
This Petition requests a grant of a priority date, at least for entry into the U.S. national phase, from a U.S. Provisional patent application No. 60/027,265 filed 25 September 1996. The Petition fee should be charged to Deposit Account No. 09-0470.

The facts supporting this Petition is as follows:

1. The priority application was filed in the USPTO on 25 September 1996 as Provisional Application No. 60/027,265. The application, as filed, included Table I a copy of which is attached as Exhibit A. In Table I both the Russian and English languages identified titles of the several columns. Since a US Provisional Application is not examined except for formalities no objection was made to the language used in the Table.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with sufficient postage to the United States Postal Service as First Class Mail in an envelope addressed to: Box PCT, Assistant Commissioner for Patents, Washington, DC 20231, on the date indicated below.


Dolores K. Tillson

Date: July //, 2001

2. A PCT Request 101, attached Exhibit B, designating US, was timely filed 22 September 1997 claiming priority to application 60/027,265. This International Application is identified as PCT/US97/16812. The Checklist Box No. VIII for the documents of the International Application indicated 11 sheets for the description and 3 sheets for the drawings. Table I is not referred to in the Brief Description of the Drawings in the International Application. Table I is referred to on page 9, lines 23/24 as "attached". Table I does not appear in the application as a page, numbered or otherwise, of the description

3. The US/RO mailed to the applicant on 8 October 1997 an Invitation to Correct the Purported International Application, attached as Exhibit C. The Invitation advised that the *description* (not the drawing) is not entirely in the prescribed language accepted by the RO/US i.e., English, citing PCT Rule 12. The basis for the Invitation is presumably the Russian language titles for the several columns in Table 1, which was submitted by the Applicant as one of three sheets of drawing and not part of the description.

4. In response to the Invitation to Correct the applicant submitted on 22 October 1997 to the RO/US the enclosed statement and affidavit, attached as Exhibit D, arguing that under PCT Rule 91 the alleged defect is obvious and that the English language equivalent is present as attested by a translator conversant in both the English and Russian languages. A copy of the postcard acknowledging receipt having the date and stamp of the PCT/PTO as 22 October 1997 is enclosed as Exhibit E.

5. Since the alleged non-English language defect is in a drawing and not in the description, the defect can be corrected, if necessary without affecting the International Filing Date under PCT Rule 12.1(b).

6. The Applicant did not receive a response from the RO/US to the documents submitted under item 4. The Applicant telephoned the PCT/RO/US after 22 October 1997 and prior to 24 December 1997 to inquire about the status of the International Application and the documents indicated in item 4. The Applicant was advised that the documents indicated in item 4 were not in the PCT file.

7. Applicant's statement dated 22 October 1997, page 2, paragraph 2, erroneously identified Table I as "not a drawing but is part of the description"

8. The applicant also received with the mailing of the Invitation to Correct Defects, item 4 above, an amended Sheet 1 of the Request, Exhibit F, amending the International Filing Date from 22 September 1997 to 22 October 1997 and amending on Sheet 7 Box VIII from 11 sheets of description to 12 sheets of description and amending the drawings from 3 sheets to 2 sheets. There is no basis for the change other than Applicant's erroneous identification of Table I as part of the description rather than a sheet of drawing.

9. Nevertheless, in response to an Invitation to Correct Defects mailed 24 December 1997 the applicant submitted on 6 February 1998 the enclosed new Table 1, Exhibit G, to replace Table I as filed. In the new Table I the Russian text is deleted leaving only English language text.

10. The applicant received on 22 April 1998 PCT/RO/111 mailed by the RO/US on 20 April 1998, Exhibit H, a Notification of Correction or Cancellation of Priority Claim advising that the priority claim has been canceled *ex officio*.

11. The applicant received on 7 May 1998 PCT/IB/317 mailed by the PCT/IB on 30 April 1998, Exhibit I, a Notification of Correction, Cancellation or Withdrawal of Priority Claim advising that the priority claim has been canceled *ex officio* by the receiving Office.

12. On 15 May 1998 the Applicant filed a Demand in the EPO for further proceedings of the International Application under Chapter II of the Patent Cooperation Treaty. The due date for the Demand, if a priority of 25 September 1996 is claimed, is 25 April 1998. The due date for the Demand, if there is no priority entitlement, is 22 May 1999. The EPO Notification of Receipt of Demand, dated 28 May 1998, Exhibit J, amended the Demand to indicate an International Filing Date and Earliest Filing Date as 22 October 1997.

The Applicant believes that application filed for entry into the U. S. national phase is entitled to the priority of the U.S. Provisional Application filed 25 September 1996 for the following reasons:

A. The apparent only basis for denying the priority claim for the PCT International Application is the non-English language in Table I. However, Table I also includes the self-evident English language for each of the non-English, certainly self-evident to one skilled in the art.

B. The failure of the RO/US to respond to the documents submitted by the Applicant, as item 4 was prejudicial to the Applicant's ability to timely proceed with the International Application entitled to a priority of 25 September 1996.

C. The failure of the RO/US to recognize the self-evident merits of the documents submitted by the Applicant as item 4 initiated a series of events in the RO/US and IB, which denied the priority claim of 25 September 1996.

D. The RO/US erroneously and without justification changed Box VIII of the Request as filed to indicate 12 sheets of description and 2 sheets of drawing. PCT Rule 11.10(c) indicates that the description *may* contain tables (emphasis added). It is not mandatory that a table be part of the description.

E. PCT Art. 3.4(i) advises that the international application must be filed in one of the prescribed languages, which includes English and Russian. The language requirement is dependent on the ability of the chosen International Searching Authority to accept the language for the search. In the present application, the International Searching Authority is the European Patent Office. The European Patent Office will, can and does accept both the English and Russian languages in the same application for the Search. Compare the amendment to the PCT, which entered into force 1 July 1998.

F. PCT Art. 11 advises that the RO shall accord as the international filing date the date of receipt of the international application providing that RO has found that, at the time of receipt, the application is in the prescribed language. Compare the amendment to the PCT, which entered into force 1 July 1998.

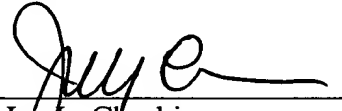
G. Under U.S. patent practice, the U.S. Patent and Trademark Office will accept an application and give a filing date to such application where the text matter in the application is not entirely in the English language. Any subsequent translation submitted of the non-English text will not affect the filing date. An application filed under the PCT should not be treated in a different and prejudicial manner.

The Applicant therefore requests that the application filed as the International Application be granted a priority of 25 September 1996.

The Applicant therefore requests that the application filed for entry into the U.S. national phase be granted a priority of 25 September 1996.

Respectfully submitted,

GENERAL ELECTRIC COMPANY et al.

By 
Jay L. Chaskin
Attorney for Applicant